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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/534,712

05/12/2005

Keiji Hirao

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EXAMINER

WOO, STELLA L

ART UNIT

PAPER NUMBER

2614

MAIL DATE

DELIVERY MODE

05/22/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/534,712	Applicant(s) HIRAO ET AL.	
	Examiner Stella L. Woo	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1- are rejected under 35 U.S.C. 103(a) as being unpatentable over Boys (US 2002/0001303 A1) in view of Schmidt (US 6,522,894 B1).

Regarding claim 1, Boys discloses a contents reproducing apparatus with telephone function (Internet radio device with IP telephony), comprising:

a reproducing means for selectively reproducing a telephone voice signal and a first content signal (IP telephony mode switch 803 enables toggle capability between IP telephony or Internet radio mode; paragraph 110);

a generating means for generating a second content signal (audio can be generated from another audio-broadcast source; paragraphs 47, 73);

a disabling means for disabling said generating means when a reproducing signal by said reproducing means is said first content signal (selection between audio-broadcast sources is made via selection buttons; paragraph 73), and

an activating means for activating said generating means when a reproducing signal by said reproducing means is said telephone voice signal (user can listen to music while conducting telephony simultaneously; paragraph 119).

Boys differs from claim 1 in that it does not teach automatically reactivating the generating means upon terminal of the telephone voice signal. However, Schmidt, from the same field of endeavor, teaches automatically reverting to a default mode (e.g. radio mode) when a phone call has ended (Figure 3, steps 260, 190; col. 6, lines 26-36). It would have been obvious to an artisan of ordinary skill to incorporate such automatic reversion to radio mode at the end of a phone call, as taught by Schmidt, within the apparatus of Boys so that the user need not manually return to the radio mode after the interrupting telephone call has ended.

Regarding claim 2, in Boys, Internet radio audio and IP telephony audio can be output to either the speaker system or a headset/earpiece (paragraph 10).

Regarding claims 3, 5-6, 8, in Boys, Internet radio audio and IP telephony audio can be received via a wired medium such that the device can be a fixed, table-top radio/phone (paragraph 120).

Regarding claims 4 and 7, in Boys, the two Internet audio-broadcast sources can be from the same genre since they are selected by the user (paragraph 73).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 9, 3-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Boys for the same reasons applied to claims 2-8 in the last Office action and repeated below.

Regarding claim 9, Boys discloses a contents reproducing apparatus with telephone function (Internet radio device with IP telephony), comprising:

a reproducing means for selectively reproducing a telephone voice signal and a first content signal (IP telephony mode switch 803 enables toggle capability between IP telephony or Internet radio mode; paragraph 110);

a generating means for generating a second content signal (audio can be generated from another audio-broadcast source; paragraphs 47, 73);

a disabling means for disabling said generating means when a reproducing signal by said reproducing means is said first content signal (selection between audio-broadcast sources is made via selection buttons; paragraph 73), and

an activating means for activating said generating means when a reproducing signal by said reproducing means is said telephone voice signal (user can listen to music while conducting telephony simultaneously; paragraph 119);

a first output means and a second output means (Internet radio audio and IP telephony audio can be output to either the speaker system or a headset/earpiece; paragraph 10).

Regarding claims 3, 5-6, 8, Internet radio audio and IP telephony audio can be received via a wired medium such that the device can be a fixed, table-top radio/phone (paragraph 120).

Regarding claims 4 and 7, the two Internet audio-broadcast sources can be from the same genre since they are selected by the user (paragraph 73).

Response to Arguments

5. Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new grounds of rejection.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stella L. Woo whose telephone number is (571) 272-7512. The examiner can normally be reached on Monday-Friday, 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on (571) 272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Stella L. Woo/
Primary Examiner, Art Unit 2614